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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,127	02/20/2004	Tony M. Pearce	03886.053/5128 P	5250

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Parsons Behle & Latimer
201 South Main Street, Suite 1800
P. O. Box 45898
Salt Lake City, UT 84111

EXAMINER

SANTOS, ROBERT G

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,127

Applicant(s)

PEARCE, TONY M.

Examiner

Robert G. Santos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 9-12, 14-23, 39-42 and 47-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 5,749,111. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application and the claims in the patent are drawn to cushioning elements (arranged in different sequences) *each* comprising a quantity of gel cushioning medium formed to have a top, a bottom and a first outer periphery, the medium being compressible so that it will deform under the compressive force of a cushioned object; wherein the cushioning medium is flexible and resilient, having shape memory and being substantially solid and non-flowable at temperatures below 130 degrees Fahrenheit; a plurality of hollow columns (of varying sizes, shapes and dimensions) formed in the cushioning medium, each of the hollow columns having a longitudinal axis along its length, each of the hollow columns having a column wall which defines a first hollow column interior, and each of the

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hollow columns having two ends; wherein each of the column ends is positioned at two different points of the first longitudinal axis; wherein at least one of the hollow columns of the cushioning element is positioned within the gel cushioning medium such that the longitudinal axis is positioned generally parallel to the direction of a compressive force exerted on the cushioning element by a cushioned object in contact with the cushioning element; wherein the cushioning element is adapted to have a cushioned object placed in contact with the cushioning element top; and wherein at least one of the column walls of the cushioning element is capable of buckling beneath a protuberance that is located on the cushioned object.

3. Claims 8, 13, 24-27, 31-38, 46 and 61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 5,749,111 in view of U.S. Pat. No. 3,548,420 to Spence. Pearce '111 lacks the use of a second cushioning element including foam. Spence '420 provides the basic teaching of a cushioning element (10) comprising a semisolid gel medium (11) placed between a pair of flexible sheets (12, 13) formed from a foamed material (as described in column 3, lines 39-42). The skilled artisan would have found it obvious at the time the invention was made to provide the cushion of Pearce '111 with a second cushioning element including foam in order to "protect the body [of a user] against localized pressures directed against the surface of the body", thereby providing enhanced user comfort (see Spence '420, column 2, lines 26-31).

4. Claims 5-7 and 43-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 5,749,111 in

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view of Hudson '746. Pearce '111 lacks the use of a quilted top covering including fiber and foam. Hudson '746 provides the use of a quilted top cover (14) including both fiber (56) and foam (28). The skilled artisan would have found it obvious at the time the invention was made to provide the cushion of Pearce '111 with a quilted top covering including fiber and foam in order to provide "a smooth, relatively continuous surface in contact with the user rather than a surface of spaced points", thereby providing enhanced user comfort (see Hudson '746, column 1, lines 60-62).

5. Claims 28-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 5,749,111 in view of Spence '420 and Hudson '746. Pearce '111 as modified by Spence '420 lacks the use of a quilted top covering including fiber and foam. Hudson '746 provides the use of a quilted top cover (14) including both fiber (56) and foam (28). The skilled artisan would have found it obvious at the time the invention was made to provide the cushion of Pearce '111 as modified by Spence '420 with a quilted top covering including fiber and foam in order to provide "a smooth, relatively continuous surface in contact with the user rather than a surface of spaced points", thereby further providing enhanced user comfort (see Hudson '746, column 1, lines 60-62).

6. Claim 62 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,749,111 in view of Pouch '790. Pearce '111 lacks the use of a second cushioning element including at least one spring. Pouch '790 provides the use of a cushioning element (A) including a base (C) having a plurality

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of springs (B) disposed thereon. The skilled artisan would have found it obvious at the time the invention was made to provide the cushion of Pearce '111 with a second cushioning element including at least one spring in order to impart "enhanced pressure distribution and circulation" to a user positioned thereon, thereby also providing enhanced user comfort (see Pouch '790, column 1, lines 41-43).

Conclusion


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pearce et al. '396, Kuo '926, Pearce '986, Pearce '099, Pearce '098, Kuo '005, Kuo '003, Lampel '830, Pearce '899, Lampel '663, Pearce '458, Gaither '980, Pearce '527, Dyer, Jr. '144, Nwoko '858, Fogel '006, Limb et al. '238, Goodale '658, Goodale '564, Limb et al. '514, Spence '973 and Spence '491.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert G. Santos whose telephone number is (703) 308-7469. The examiner can normally be reached on Tues-Fr and first Mondays, 10:30 a.m. to 8:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert G. Santos
Primary Examiner
Art Unit 3673

R.S.
February 3, 2005